

Application No.: 09/632,139
Appeal Brief Dated: September 30, 2009
Reply to Notice of: September 1, 2009

MAT-3720US4

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 09/632,139
Applicant: Ryoichi IMANAKA
Filed: August 3, 2000
Title: SERVER APPARATUS, SUBSCRIBER APPARATUS AND
INFORMATION ON DEMAND SYSTEM
TC/A.U.: 2424
Examiner: Rueben M. Brown
Confirmation No.: 2101
Docket No.: MAT-3720US4

APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice Of Appeal dated **July 2, 2009**, and the Notice of Panel Decision from Pre-Appeal Brief Review dated **September 1, 2009**, Appellant is submitting this Appeal Brief for the above-identified application.

I. REAL PARTY IN INTEREST

The real party in interest is Panasonic Corporation.

II. RELATED APPEALS AND INTERFERENCES

There are no appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 14, 17-19, 21, 22, 37, 40-42, 45, 47, 49, 51, 53, 55 and 57-68 are pending. Claims 60-68 have been objected to. Claims 14, 17-19, 21, 22, 37, 40-42, 45, 47, 49, 51, 53, 55, and 57-59 are rejected.

IV. STATUS OF AMENDMENTS

No amendments have been filed subsequent to Final Rejection.

V. SUMMARY OF CLAIMED SUBJECT MATTER

Claim 14 of the present application relates to a computer information system. A provider may be a server apparatus as shown on the left side of Fig. 1 (col. 2, lines 39-41). The provider may receive signaling from a recipient (col. 2, lines 65 - col. 3, line 1). The recipient may be a subscriber apparatus as shown on the right side of Fig. 1 (col. 2, lines 64-65). The signaling from the recipient is for the provider to provide information to the recipient (col. 3, line 31). The provider provides information to the recipient responsive to the signaling (col. 3, lines 47-50). The provider charges a different amount for providing information to the recipient depending upon whether or not the information is recorded or permitted to be recorded in a non-sequentially accessible medium. As explained at col. 3, line 64 et seq. "charging apparatus 4 is set so that the charging amount is larger when the audio/video information is provided to the subscriber's recording/reproducing apparatus 9 then when provided to the subscriber's display terminal 10 ...". Recording of the information in the medium is permitted if a value of an identifier read from the medium is a registered ID value (col. 8, line 22). Recording of the information medium is prevented if any registered ID value is not readable from the medium (col. 8, line 22).

Claim 17 of the present application relates to a method of processing information. Information is provided to a recipient from a server apparatus as shown on the left side of Fig. 1 (col. 2, lines 39-41). The provider (which provides the information) may receive signaling from a recipient (col. 2, lines 65 - col. 3, line 1). The recipient may be a subscriber apparatus as shown on the right side of Fig. 1 (col. 2, lines 64-65). The signaling from the recipient is for the provider to provide information to the recipient (col. 3, line 31). The provider provides information to the recipient responsive to the signaling (col. 3, lines 47-50). The provider charges a different amount for providing information to the recipient depending upon whether or not the information is recorded or permitted to be recorded in a non-sequentially accessible medium. As explained at col. 3, line 64 et seq. "charging apparatus 4 is

set so that the charging amount is larger when the audio/video information is provided to the subscriber's recording/reproducing apparatus 9 then when provided to the subscriber's display terminal 10 ...” Recording of the information in the medium is permitted if a value of an identifier read from the medium is a registered ID value (col. 8, line 22). Recording of the information medium is prevented if any registered ID value is not readable from the medium (col. 8, line 22).

Claim 18 of the present application relates to a method of processing information. A provider may receive signaling from a recipient (col. 2, lines 65 - col. 3, line 1). The signaling from the recipient is for the provider to provide information to the recipient (col. 3, line 31). Information is received from the provider responsive to the signaling (col. 3, lines 47-50). The provider charges a different amount for providing information to the recipient depending upon whether or not the information is recorded or permitted to be recorded in a non-sequentially accessible medium. As explained at col. 3, line 64 et seq. “charging apparatus 4 is set so that the charging amount is larger when the audio/video information is provided to the subscriber's recording/reproducing apparatus 9 then when provided to the subscriber's display terminal 10 ...” Recording of the information in the medium is permitted if a value of an identifier read from the medium is a registered ID value (col. 8, line 22). Recording of the information medium is prevented if any registered ID value is not readable from the medium (col. 8, line 22).

Claim 19 of the present application relates to a computer information system. A provider may receive signaling from a recipient (col. 2, lines 65 - col. 3, line 1). The signaling from the recipient is for the provider to provide information to the recipient (col. 3, line 31). The recipient receives information from the provider responsive to the signaling (col. 3, lines 47-50). The provider charges a different amount for providing information to the recipient depending upon whether or not the information is recorded or permitted to be recorded in a non-sequentially accessible medium. As explained at col. 3, line 64 et seq. “charging apparatus 4 is set so that the charging amount is larger when the audio/video information is provided to the subscriber's recording/reproducing apparatus 9 then when provided to the subscriber's display terminal 10 ...” Recording of the information in the medium is permitted if a value of an identifier read from the medium is a registered ID value

(col. 8, line 22). Recording of the information medium is prevented if any registered ID value is not readable from the medium (col. 8, line 22).

Claim 21 of the present application relates to a signal transmitted from a recipient of information to a provider of information (col. 2, lines 65 - col. 3, line 1). The signal indicates that recording of the information in the medium is permitted or has occurred if a value of an identifier read from the medium is a registered ID value (col. 8, line 22). Recording of the information medium is prevented if any registered ID value is not readable from the medium (col. 8, line 22). Providing of the information is responsive to signaling from a recipient for a provider to provide information to the recipient (col. 3, lines 31-50). A different for providing information is charged recipient depending upon whether or not the information is recorded or permitted to be recorded in a non-sequentially accessible medium. As explained at col. 3, line 64 et seq. "charging apparatus 4 is set so that the charging amount is larger when the audio/video information is provided to the subscriber's recording/reproducing apparatus 9 then when provided to the subscriber's display terminal 10 ..."

Claim 22 of the present application relates to a method of processing information. Signaling from a recipient is for a provider to provide information to the recipient (col. 3, line 31). The information is provided to the recipient responsive to the signaling (col. 3, lines 47-50). Recording of the information in the medium is permitted or has occurred if a value of an identifier read from the medium is a registered ID value (col. 8, line 22). Recording of the information medium is prevented if any registered ID value is not readable from the medium (col. 8, line 22). A different amount for providing the information is charged depending upon whether or not the information is recorded or permitted to be recorded in a non-sequentially accessible medium. As explained at col. 3, line 64 et seq. "charging apparatus 4 is set so that the charging amount is larger when the audio/video information is provided to the subscriber's recording/reproducing apparatus 9 then when provided to the subscriber's display terminal 10 ..."

Claim 37 of the present application relates to an information receiver. Signaling is received from a recipient (col. 2, lines 65 - col. 3, line 1). The signaling from the recipient is for the provider to provide information to the recipient (col. 3,

line 31). The provider provides information to the recipient responsive to the signaling (col. 3, lines 47-50). Recording of the information in the medium is permitted or has occurred if a value of an identifier read from the medium is a registered ID value (col. 8, line 22). Recording of the information medium is prevented if any registered ID value is not readable from the medium (col. 8, line 22). A different amount for providing information to the recipient is charged depending upon whether or not the information is recorded or permitted to be recorded in a non-sequentially accessible medium. As explained at col. 3, line 64 et seq. "charging apparatus 4 is set so that the charging amount is larger when the audio/video information is provided to the subscriber's recording/reproducing apparatus 9 then when provided to the subscriber's display terminal 10 ..."

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 14, 17-19, 21, 22, 37, 40-42, 47, 49, 51, 53, 55, and 57-59 are allowable under 35 U.S.C. § 103(a) in view of the combination of Horton (US 4,945,563) in view of Brownstein (US 5,671,202) and Cohen (US 4,949,187).

VII. ARGUMENT

Claims 14, 17-19, 21-22, 37, 40, 42, 45, 47, 49, 51, 53, 55 and 57 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Horton (US 4,945,563) in view of Brownstein (US 5,671,202) and Cohen (US 4,949,187). It is respectfully submitted, however, that these claims are patentable over the art of record for the reasons set forth below.

Appellant's invention, as recited by claim 14, includes a feature which is neither disclosed nor suggested by the art of record, namely:

... a provider ... for providing said information to said recipient ...

... said provider charging a different amount for providing said information to said recipient depending upon whether or not said information is recorded or permitted to be recorded ...

In other words, information is provided to a recipient. If the information is recorded (or permitted to be recorded), then one amount is charged. If the information is not recorded (or not permitted to be recorded), then another amount is charged.

Implicit in the above statement is the fact that information provided to the recipient is charged a first amount if it is recorded and a second amount if it is not recorded. For a prior art rejection to be proper, the prior art rejection must disclose two different amounts being charged for the providing of information. In other words, the prior art must disclose that a first amount is charged if the information is recorded AND a second amount is charged if the information is not recorded. To put it another way, if the prior art permits viewing of information, and the prior art does not permit recording of that information, then the prior art has not disclosed Appellant's claimed feature. Both recording and the prevention of recording (at two respectively different monetary amounts) must be disclosed for the prior art to be used in a proper rejection.

As set forth above, three references have been asserted against Appellant's independent claims. The primary reference asserted against Appellant's independent claims is Horton. As explained below, Horton is not a proper reference. To summarize, Horton discloses the following four modes of operation, each mode of operation will be separately discussed.

View:

In this mode, a program can be viewed, but it cannot be recorded. This mode does not read on Appellant's claims because the mode does not include different charges depending upon whether or not the program is recorded. In fact, recording is not permitted (irrespective of charges). Thus, this mode does not read on Appellant's claims.

View and Tape for Fee:

In this mode, it is possible to view a program and record a program. However, the fee for viewing the program and recording the program are one and the same. Thus, this mode does not read on Appellant's claims.

View and Tape for Free:

In this mode, also, a program can be recorded. But, there is no charge for viewing and recording the program. And, again, the "charge" (namely, 0) for viewing the program and recording the program is the same. Thus, this mode does not read on Appellant's claims.

Sneak Preview:

In this mode, the program can be viewed, but the program cannot be recorded. Thus, this mode does not read on Appellant's claim.

The chart below summarizes these modes:

| MODE | VIEWING CHARGE | RECORDING CHARGE | DESCRIBED IN HORTON | VIEWING (WITHOUT RECORDING) CHARGE AND RECORDING CHARGE DIFFERENT? |
|------------------------|----------------|------------------|---------------------|--|
| View | No | N/A | Col. 3, lines 51-52 | No |
| View and Tape for Fee | Yes | Yes | Col. 3, lines 50-51 | No |
| View and Tape for Free | No | No | Col. 3, lines 47-49 | No |
| Sneak | No | N/A | Col. 4, lines 27-30 | No |

Thus, Horton does not include any disclosure of charging two different amounts "whether or not" a program is recorded (or permitted to be recorded). Thus, Horton does not read on Appellant's claims.

The Official Action combines Horton with Brownstein and Cohen. Cohen was combined because Cohen discloses the ability to view programs "on demand." Brownstein was cited because Brownstein discloses Appellant's claimed feature of "identifier read from said recording medium." Neither reference, however, makes up for the deficiency of Horton, namely, charging "a different amount" depending upon "whether or not" the information is recorded.

Appellant wishes to advance a second argument as to why the prior art of record neither discloses nor suggests Appellant's claimed invention. As previously stated, Cohen discloses the feature of "on demand." Even by combining Horton and Cohen, the ability to charge different amounts based on whether or not a program is recorded which has been requested on demand is neither disclosed nor suggested.

KSR allows references to be combined when there is no synergy from claimed features. Appellant's claims, however, have synergy namely the charging of different amounts depending upon whether or not a program is recorded based on an on demand request. The ability to charge different amounts depending upon whether or not a program is recorded based on an on demand request is neither disclosed nor suggested by the art of record.

The remaining independent claims, while not identical to claim 14, are similarly patentable over the art of record for reasons similar to those set forth above with regard to claim 14.

Claims 41, 58, 59 are dependent claims which have been rejected by combining Horton, Brownstein and Cohen with other references. Those claims, however, are patentable by virtue of their dependency on allowable independent claims.

The remaining dependent claims from the rejection statement are allowable by virtue of their dependency on allowable independent claims.

In view of the above arguments, reversal of the rejections of record is respectfully requested.

Respectfully Submitted,

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Enclosure: Appendix of Claims

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FP_551887

APPENDIX OF CLAIMS

Listing of Claims:

1.-13. (Cancelled).

14. A computer information system, comprising:

a provider for receiving signaling from a recipient for said provider to provide said information to said recipient and for providing said information to said recipient responsive to said signaling;

said provider charging a different amount for providing said information to said recipient depending upon whether or not said information is recorded or permitted to be recorded in a non-sequentially accessible medium; and

recording of said information in said medium is permitted if a value of an identifier read from said medium is a registered ID value,

recording of said information in said medium is prevented if any registered ID value is not readable from said medium.

15.-16. (Cancelled).

17. A method of processing information, said method comprising the steps of:

providing information to a recipient responsive to signaling received from said recipient for said provider to provide said information to said recipient;

charging a different amount for providing said information depending upon whether or not said information is recorded or permitted to be recorded in a non-sequentially accessible medium; and

permitting recording of said information in said medium if a value of an identifier read from said medium is a registered ID value, preventing recording of said information in said medium if any registered ID value is not readable from said medium.

18. A method of processing information, said method comprising the steps of:

receiving information from a provider responsive to signaling received from said recipient for said provider to provide said information to said recipient;

charging a different amount for providing said information depending upon whether or not recording of said information in a non-sequentially accessible medium occurs or is permitted; and

recording of said information in said medium is permitted if a value of an identifier read from said medium is a registered ID value,

recording of said information in said medium is prevented if any registered ID value is not readable from said medium.

19. A computer information system, comprising:

a recipient for receiving information from a provider responsive to signaling received from said recipient for said provider to provide said information to said recipient;

said recipient being charged a different amount for providing said information depending upon whether or not recording of said information in a non-sequentially accessible medium occurs or is permitted; and

recording of said information in said medium is permitted if a value of an identifier read from said medium is a registered ID value,

recording of said information in said medium is prevented if any registered ID value is not readable from said medium.

20. (Cancelled).

21. A signal transmitted from a recipient of information to a provider of information, said signal indicating that recording of said information in a non-sequentially accessible medium is permitted or has occurred if a value of an identifier read from said medium is a registered ID value, recording of said information in said

medium is prevented if any registered ID value is not readable from said medium, wherein providing of said information responsive to signaling received from said recipient for said provider to provide said information to said recipient is charged differently depending upon said signal irrespective of whether said information is viewed.

22. A method of processing information, said method comprising the step of:

transmitting a signal from a recipient of information, that receives said information responsive to signaling received from said recipient for said provider to provide said information to said recipient, to a provider of said information, said signal indicating that recording of a non-sequentially accessible information in said medium is permitted if a value of an identifier read from said medium is a registered ID value, recording of said information in said medium is prevented if any registered ID value is not readable from said medium, wherein said information is charged differently depending upon said signal irrespective of whether said information is viewed.

23.-36. (Cancelled).

37. An information receiver comprising:

a receiving unit to receive information from a provider responsive to signaling received from said recipient for said provider to provide said information to said recipient; and

a recording unit to record the information in a non-sequentially accessible medium,

the recording of the information in the medium is permitted if a value of an identifier in the medium is a registered ID value,

recording of said information in said medium is prevented if any registered ID value is not readable from said medium, and

a different amount for providing said information being charged based on whether or not the information is recorded or permitted to be recorded or permitted to be recorded in the medium.

38.-39. (Cancelled).

40. The information receiver according to claim 37, further comprising:

an information designating unit to designate the information.

41. The information receiver according to claim 37, further comprising:

an informing unit to inform that the identifier is wrong if the identifier is not registered.

42. The information receiver according to claim 37, the information includes at least one of audio and video information, audio information, video information, a computer program, and game software.

43.-44. (Cancelled).

45. A computer information system according to claim 14, wherein said registered ID value is provided by said provider.

46. (Cancelled).

47. A method of processing information according to claim 17, wherein said registered ID value is provided by said provider.

48. (Cancelled).

49. A method of processing information according to claim 18, wherein said registered ID value is provided by said provider.

50. (Cancelled).

51. A computer information system according to claim 19, wherein said registered ID value is provided by said provider.

52. (Cancelled).
53. A signal transmitted according to claim 21, wherein said registered ID value is provided by said provider.
54. (Cancelled).
55. A method of processing information according to claim 22, wherein said registered ID value is provided by said provider.
56. (Cancelled).
57. An information receiver according to claim 37, wherein said registered ID value is provided by said provider.
58. A computer information system according to claim 14, wherein:
a drive ID is checked, and
if said drive ID is registered, recording of said information in said medium is permitted.
59. A computer information system according to claim 14, further comprising:
a memory for storing said information, wherein said stored information is erased after a designated time.
60. The computer information system according to claim 14,
said signaling further contains a flag indicating an output to which the recipient outputs the information, and
said provider charging the different amount for providing said information based on the flag.
61. A method of processing information according to claim 17,

said signaling further contains a flag indicating an output to which the recipient outputs the information, and

said provider charging the different amount for providing said information based on the flag.

62. A method of processing information according to claim 18,

said signaling further contains a flag indicating an output to which the recipient outputs the information, and

said provider charging the different amount for providing said information based on the flag.

63. A computer information system according to claim 19,

said signaling further contains a flag indicating an output to which the recipient outputs the information, and

said provider charging the different amount for providing said information based on the flag.

64. A method of processing information according to claim 22,

said signaling further contains a flag indicating an output to which the recipient outputs the information, and

said provider charging the different amount for providing said information based on the flag.

65. An information receiver according to claim 37,

said signaling further contains a flag indicating an output to which the recipient outputs the information, and

said provider charging the different amount for providing said information based on the flag.

66. The computer information system according to claim 60,

said provider further contains a recipient's mode recognizing apparatus receiving said flag and recognizing said output to which said recipient outputs said information in accordance with the flag.

67. The computer information system according to claim 66,

said provider further contains a charging apparatus charging said different amount for providing said information based on said output recognized and corresponding charges.

68. The computer information system according to claim 67,

said signaling contains an ID number of requested audio/video information, and

said provider further contains a information providing apparatus providing said information identified by the ID number of requested audio/video information, responsive to said signaling,

wherein said charging and said providing are processed in charging apparatus and information providing apparatus respectively, responsive to said signaling received by said provider.

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EVIDENCE APPENDIX

None.